

REMARKS

Following entry of this Amendment, claims 1-16 and 18-21 are pending in the application. Claims 1, 9 and 18 have been amended to clarify that which the Applicants' believe to be novel subject matter. Specifically, claims 1, 9 and 18 are amended to claim that "analysing said trace file" involves the process of identifying a minimum set of test events and, therefore, "extraction the minimum set" is not so broad as to include the extraction of all test events unless the identified minimum set includes all test events. Claim 18 is amended according to the Examiner's suggestion to obviate the §101 rejection. In addition claims 11 and 20 are amended to correct minor typographical errors.

Rejections Based Upon 35 U.S.C. §101

Claim 18-21 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claim 18 is amended as per the Examiner's suggestions to obviate this rejection. Therefore, Applicants respectfully request withdrawal of the §101.

Rejections Based Upon 35 U.S.C. §102(e)

Claims 1-6, 8-14 and 16-17 stand rejected under 35 U.S.C. §102(e) as being anticipated by a patent by Gustavsson et al. (U.S. Patent No. 6,804,796; hereinafter referred to as "Gustavsson"). Claims 1, 9 and 18 are amended to clarify that the "analysing said trace file" involves identifying a minimum set of test events. Therefore, the "extraction" now acts upon that identified minimum set rather than the entire set of test events within the trace file. Applicants believe this resolves the issue discussed in the Examiner Interview of January 9, 2007 in which it was pointed out that removing all test events would also remove any minimum set. By first identifying the minimum set before extraction, the claimed may still extract all events but only if all the events together make up a minimum set.

With respect to independent claims 1 and 9, Gustavsson neither teaches nor suggests an "identifying a minimum set of test events". (Claims 1, 9 and 18), which is then extracted. Simply stated, Gustavsson is directed to a system that saves entire sets of test inputs and corresponding test outputs without making any determination as to whether a particular test event is necessary for a complete test. In contrast, Applicants' claimed subject matter is directed to a system that, among other things, saves some test inputs and may not save others, thus the

identification and extraction of a minimum set. The advantage of this approach over Gustavsson is that saved testing situations are more compact and portable. The cited portions of Gustavsson with respect to this element address verification but not identification, specifically the removal of selected test inputs from corresponding test outputs after determining that the specific inputs are not necessary to produce the output. After a careful review of the remainder of Gustavsson, Applicants do not believe that the cited art teaches this particular element.

To reject a claimed invention under §102, all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, "All words in a claim must be considered in judging the patentability of that claim against prior art." (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Therefore, Applicants respectfully request withdrawal of the §102(e) rejections of claims 1-6, 8-14 and 16.

Rejections Based Upon 35 U.S.C. §103(a)

Claims 7 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gustavsson. Claims 7 and 15 are dependent upon allowable independent claims and, therefore, Applicants respectfully request withdrawal of the rejections based upon §103(a).

CONCLUSION

It is respectfully submitted that all issues and rejections have been adequately addressed and that pending claims 1-16 and 18-21 are allowable and that the case should be advanced to issuance. If the Examiner has any questions or wishes to discuss the claims, the Examiner is encouraged to call the undersigned at the telephone number indicated below.

It is believed that no fees are due with the filing of this Amendment. However, should any fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of International Business Machines Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

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